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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,350	10/30/2003	Dyson W. Hickingbotham	2528US	7492
26356	7590	04/10/2007		
ALCON IP LEGAL, TB4-8 6201 SOUTH FREEWAY FORT WORTH, TX 76134			EXAMINER SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3735	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/10/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/697,350	Applicant(s) HICKINGBOTHAM, DYSON W.	
	Examiner david shay	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 7, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 7, 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/3/2004&10/7/2005</u> | 6) <input type="checkbox"/> Other: _____ |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The drawings are objected to because Figure 1 appears to be a poor quality photocopy with many extraneous dots and few features of the actual device discernable therefrom; in Figure 2, the lines are of poor quality; Figure 3 appears to be a poor quality photocopy with many extraneous dots and few features of the actual device discernable therefrom. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "optical element [that] is a 19, 20, or 25 gauge optical element"; "cannula and handpiece are fabricated from biocompatible

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materials”; “the optical fiber is optically coupled...at another end to an optical cable...wherein the optical cable comprises...a second optical connector operably coupled to the handpiece”; “the optical cable gauge and the optical fiber gauge are equal”; “the optical cable comprises a plurality of optical fibers”; “the first and second optical connectors are SMA optical fiber connectors”; the optical coupling to the handpiece “to enable linear displacement of the optical fiber”; the “push/pull mechanism”; “the amount of linear displacement of the optical fiber determines an angle of illumination and an amount of illumination”; the “beam of relatively incoherent light”; the “xenon light source”; the optical element being “about 2 millimeters long”.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

It is noted that claims 11 and 30 contain a means plus function recitation.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-17 and 24-37 are indefinite, as it is unclear what, if any difference in scope exists between claims 5, 6, 7, 8, 9, 10, 11, 12, 16, 17, and 18 and 24, 26, 27, 25, 28, 29, 30, 31, 35, 36, and 37, respectively. In claims 12 and 31 exactly what is intended to be encompassed by the term "push/pull mechanism" is unclear. Claims 13 and 32 are indefinite as what further structure is to be recited thereby is unclear. In claims 16 and 35, exactly what is intended to be encompassed by the term "relatively coherent light" is unclear. In claim 17, "the light source" lacks positive antecedent basis.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-24, and 26-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in combination with Grinblat et al. Turner teaches a wide-angle endoilluminator as claimed, except the lens being hemispherical. Grinblat et al teach an illuminator for retinal surgery wherein the optical fiber is able to be advanced or retracted. It would have been obvious to the artisan or ordinary skill to employ a linearly translatable fiber in the device of Turner, since this allows the illumination of different areas, and to employ a xenon light source, since

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these are equivalents, as taught by Grinblat et al, or to employ the lens fiber arrangement of Turner in the device of Grinblat et al, since this provides beam spreading which is superior to that of refractive surfaces directly on the end of optical fibers, as taught by Turner, and in either case to provide the precise probe diameters claimed, since this is not critical; is well within the skill of one having ordinary skill in the art; and provides no unexpected result; to employ a hemispherical, rather than a ball lens, since the distalmost surface of the lens provides little refraction when immersed in the vitreous, as taught by Turner; to employ a multifiber cable and a cable which is of the same gauge as the optical fiber, since this would provide a more flexible cable due to the use of smaller individual fibers and more efficient light transfer due to the transmitting and receiving faces having the same surface area and to provide the optical element with the same gauge as the fiber for the same reason and to provide a cable which is integral with the fiber, since this would provide the most efficient light transport, thus producing a device such as claimed.

Claims 8 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in combination with Grinblat et al as applied to claims 1-7, 9-24, and 26-37 above, and further in combination with Shen et al. Shen et al teach that SMA connectors are standard. It would have been obvious to the artisan of ordinary skill to provide SMA connectors on the optical fiber and cable, since these are standard, as taught by Shen et al, thus producing a device such as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'David M. Shay' with a stylized flourish at the end.

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330